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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,218	08/19/2003	David Blankley	P/131-1	6467

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07/10/2009

EXAMINER

COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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07/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/644,218	BLANKLEY, DAVID	
	Examiner	Art Unit	
	JACOB C. COPPOLA	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-12,14,16,18-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) 11,12,14,16,18-20 and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____. |
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DETAILED ACTION

Acknowledgements

1. This action is in reply to the Remarks filed on 04 May 2009 ("09 May Remarks"), the Remarks filed on 21 January 2009 ("09 Jan Remarks"), and the Claim Amendments filed on 21 January 2009 ("09 Jan Amendments").
2. Claims 1, 5-12, 14, 16, 18-20, and 22-24 are currently pending.
3. Claims 1 and 5-10 have been examined.
4. Claims 11, 12, 14, 16, 18-20, and 22-24 have been withdrawn, as noted below.
5. This Office Action is given Paper No. 20090708. This Paper No. is for reference purposes only.

Restrictions

6. Applicant's election of claims 1 and 5-10 in the 09 May Remarks is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
7. Claims 11, 12, 14, 16, 18-20, and 22-24 are withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the 09 May Remarks.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1 and 5-10 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 1 and 5-10

10. Based on Supreme Court precedent and recent Federal Circuit decisions, a §101 patent eligible process must (1) be tied to a particular machine (or apparatus), or (2) transform a particular article to a different state or thing. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)(en banc). This is the Machine-or-Transformation Test (“M-T Test”).

11. To meet prong (1), the method step should positively recite a machine to which it is tied. Alternatively or to meet prong (2), the method step should positively recite the material that is being changed to a different state or positively recite the subject matter that is being transformed. For example, a method claim that would not qualify as a patent eligible process because it fails both prongs of the M-T Test would be a claim that recites purely mental steps.

12. In this particular case, the process claims fail prong (1) because the method steps are not tied to a specific machine since the method steps could be performed by a human being. For example, claim 1 recites the step of “sending meta data from an author to a content repository.” The sending can be performed by a person who manually brings the meta data from the author to a repository. In this example, the sending is performed without the use of a machine.

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13. Finally, the Examiner notes that the claims fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1 and 5-10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Regarding Claim 1

16. This claim is indefinite because it is unclear whether all of the recited steps are required. This confusion is caused by the lack of the word “and” or “or.” For example, the claim should read “[step 1]; [step 2]; ***and*** [step 3],” if all of the steps are required for the claimed invention. Alternatively, the claim should read “[step 1]; [step 2]; ***or*** [step 3],” if a subset of the steps are required for the claimed invention. Claim 1 recites neither “and” nor “or.”

17. This claim recites “sending content from said author to said content repository” and “downloading said content from said author to a collaborator from said content repository.” This claim is indefinite because one of ordinary skill in this art would not understand how the content could be obtained from the author by the collaborator if the author has already sent the content to the repository. Moreover, one of ordinary skill in the art would not understand the scope of “a

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collaborator from said content repository.” The relationship of collaborator to content repository is unclear.

18. Additionally, this claim recites “meta data from an author,” “content from said author,” and “content and meta data from a final uploader.” The claim also recites “notifying all contributors regarding use of said content” (emphasis added). This claim is indefinite because it is unclear whether the emphasized “said content” is referring to the “content from said author,” the “content... from a final uploader,” or both. This claim also recites “tracking what content a user accesses.” This claim is indefinite because it is unclear whether “content a user accesses” is referring to the “content from said author,” the “content... from a final uploader,” both, or some other content that is accessed.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1 and 5-10, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Stefik et al. (U.S. 5,715,403 A) (“Stefik”), in view of Schneck et al. (U.S. 2003/0163428 A1) (“Schneck”).

Regarding Claim 1

21. Stefik discloses a method for creating derivative works (c. 40, l. 53 – c. 41, l. 44), and sending meta data from an author to a content repository (fig. 1 and table 1 with associated text); sending content from said author to said content repository (fig. 1 with associated text); uploading content and meta data from a final uploader to said content repository (fig. 1 with associated text); determining content contributors (“creator”) and royalty allocations (“associated fees”) (c. 6, l. 62+); notifying all contributors regarding use of said content (“the server generates a transaction identifier that is used in records or reports of the transaction”) (c. 31, l. 6+); and tracking what content a user accesses (“the display/execution repository **411** is further coupled to a credit server **414** to report any fees to be billed for access to a digital work”), (fig. 4b with associated text).

22. Stefik does not specifically disclose downloading said content from said author to a collaborator from said content repository;

23. Schneck, however, teaches downloading content from an author to a collaborator from a content repository (fig. 15 with associated text).

24. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the system of Stefik to allow the performance of downloading content to a collaborator as taught by Schneck since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding claims 5-10

25. The combination of Stefik and Schneck discloses the limitations of claim 1, as described above, and further discloses:

Claim 5: The method of claim 1 further comprising: collecting subscription fees for said author from a user and logging activity of said user to determine royalty allocation (Stefik, c. 23, l. 50+);

Claim 6: The method of claim 2 further comprising: billing all users on a periodic basis based on use (“the billing module may... periodically communicate billing data to a central billing facility, whereupon the user may be billed”) (Stefik, c. 3, l. 25+);

Claim 7: The method of claim 2 further comprising: determining periodically royalties owed to each author and disbursing funds (Stefik, c. 3, l. 25+);

Claim 8: The method of claim 2 further comprising: calculating said royalty allocations based on usage of each authors works (Stefik, c. 6, l. 31+);

Claim 9: The method of claim 2 further comprising: determining an algorithm to allocate royalties (“algorithm”) (Stefik, c. 46, l. 1+); and

Claim 10: The method of claim 9 wherein said algorithm varies based on type of content being sold (Stefik, c. 46, l. 1+).

Response to Arguments

35 U.S.C. §101

26. With respect to claim 1, Applicant argues “Applicant has amended the claims accordingly.” See p. 6, 09 Jan Remarks. This is not persuasive. The rejection remains.

35 U.S.C. §112, Second Paragraph

27. With respect to claim 1, Applicant argues “Applicant has amended the claim accordingly.” See p. 7, 09 Jan Remarks. This is not persuasive. The rejection remains.

Prior Art

28. With respect to claim 1, Applicant argues “neither Stefik nor Schneck, alone or in combination teach notifying contributors regarding use of their content, nor does it track what content user accesses.” See pp. 13-14, 09 Jan Remarks. The Examiner respectfully disagrees. First, the claim does not recite “notifying contributors regarding use of their content.” Accordingly, Applicant is arguing limitations that are not recited in the claims. This is improper. In response to Applicant’s argument that the references fail to show certain features of Applicant’s invention, it is noted that the features upon which Applicant relies (*i.e.*, notifying contributors regarding use of their content) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, as shown above, Stefik discloses notifying contributors of the use of content and tracking content that user accesses.

29. With respect to the withdrawn claims (*i.e.*, claims 11, 12, 14, 16, 18-20, and 22-24), Applicant’s arguments are moot in view of the claims now being withdrawn.

Conclusion

30. Applicant's 09 Jan Amendments necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

31. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1st paragraph written description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

32. Applicant is reminded that during *ex parte* examination, anticipation requires the examiner to meet the 'All Elements Test.' "It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question" *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); see also *In*

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re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.”). In other words, all elements of the claimed invention must be disclosed in some fashion for the claim to be anticipated. Additionally, the All Elements Test is equally applicable to method claims although it is each method step which must be shown. “A method or process consists of one or more operative steps, and, accordingly, it is well established that a patent for a method or process is not infringed unless all steps or stages of the claimed process are utilized.” *NTP Inc. v. Research In Motion Ltd.*, 75 USPQ2d 1763, 1790 (Fed. Cir. 2005)(citations and quotations omitted). Logically, the lack of a single structural element or step would negate anticipation. “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

33. Yet it is important to keep in mind that “[a]n anticipatory reference, however, need not duplicate word for word what is in the claims.” *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). “While a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests” *In re Bell*, 991 F.2d 781, 785, 26 USPQ2d 1529, 1532 (Fed. Cir. 1993) (citations and quotations omitted).¹ In other words, “[t]he use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-

¹ See also *In re Widmer*, 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965)(noting that a reference is not limited to its examples, but is available for all that it fairly discloses and suggests).

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33, 216 USPQ 1038, 1039 (Fed. Cir. 1983)(quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).²

34. The Examiner hereby gives notice that for anticipation, the Examiner can combine that what is old and well known in the art in combination with a reference. “A reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701. See also *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1347, 54 USPQ2d 1299, 1304 (Fed. Cir. 2000) (noting that “The brochure might nevertheless be anticipating if a person of ordinary skill in the art would understand the brochure as disclosing elements (8)-(10) and if such a person could have combined the brochure’s description of the invention with his own knowledge to make the claimed invention.”); and *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) (“Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention,” citing *In re LeGrice*, 301 F.2d at 939, 133 USPQ at 373-74.).

² See MPEP §2123, Subsection titled “Patents Are Relevant as Prior Art for All They Contain.”

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35. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

36. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Examiner, Art Unit 3621
July 8, 2009

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